



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/022,651

12/17/2001

Francis D. Palazzo

4665/6

1856

56015

7590

08/28/2006

PATTERSON & SHERIDAN, LLP/  
SEDNA PATENT SERVICES, LLC  
595 SHREWSBURY AVENUE  
SUITE 100  
SHREWSBURY, NJ 07702

EXAMINER

TRAN, HAI V

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/022,651

Applicant(s)

PALAZZO ET AL.

Examiner

Hai Tran

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 2 cancelled is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 06/09/2006 have been fully considered but they are not persuasive.

Applicant argues, "Fries does not teach or suggest any software programs in the set top terminal that determine EPG controls and present and use the control with the broadcast advertisement."

In response, the Examiner respectfully disagrees with Applicant because Fries clearly suggests the use of at least a browser along with APIs (software programs; Col. 6, lines 35-40) in the STB to draw/redraw various pages of EPG and to control interactive functions that references to various metadata associated between EPG page and associated broadcast advertisement (see Col. 9, lines 33-Col. 10, lines 65; Col. 13, lines 58-65, Col. 18, lines 8-23; Col. 19, lines 15-40)

Applicant argues, "Fries does not teach or suggest that the data structure is formatted with the broadcast advertisement. In one embodiment of the present invention, the data structure or metadata is transmitted in a private data stream with the broadcast. In another embodiment, the data structure or metadata is broadcast in the vertical blanking interval (VBI) line of the video signal."

In response, the Examiner respectfully disagrees with Applicant because Fries clearly discloses the metadata is formatted with broadcast advertisement for broadcast to the STB (see Col. 6, lines 52-55; Col. 13, lines 58-65; Col. 18, lines 18-22); as to Applicant remarks, "In one embodiment of the present invention, the data structure or

Art Unit: 2623

metadata is transmitted in a private data stream with the broadcast. In another embodiment, the data structure or metadata is broadcast in the vertical blanking interval (VBI) line of the video signal." the Examiner takes note; however, Applicant's remark could not be imported into the claim.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 1, and 3-20 define a data structure stored on computer readable medium embodying functional descriptive material. However, the claim does not define a computer-readable medium to be a memory/disk and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized").

However, the specification (at page 3, line 12-13; page 7, lines 14-15) indicates - "other forms of propagated signals (e.g. carrier waves, infrared signals, digital signals etc.) that data structure may be formatted (stored within the communication/transport

Art Unit: 2623

medium, i.e. signal) for broadcasting. Therefore, the specification defines the computer readable medium to be a signal.

A “signal” embodying functional descriptive material is neither a process (“actions”), machine, manufacture nor composition of matter (i.e., a tangible “thing”) and therefore does not fall within one of the four statutory categories of § 101. Rather, “signal” is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 3-5, and 9-21 are rejected under 35 U.S.C. 102(e) as being unpatentable over Fries (US 6317885).

Claim 1, a data structure stored on a computer readable media, the data structure comprising:

One or more data tags, each data tag used to provide information regarding a broadcast advertisement (i.e., pay-per-view; Fig. 6; Col. 7, lines 34-55);

One or more EPG action tags (i.e., ppv events), each EPG action tag used to define a valid EPG feature (i.e., buy ppv) that may be accessed from within the broadcast advertisement, the EPG feature being related to at least one of the broadcast advertisement and a program (ppv program) associated with the broadcast advertisement (Col. 13, lines 58-65; Col. 18, lines 8-23);

The data structure operatives to provide a link between broadcast advertisement and an EPG to provide access to EPG features defined by the EPG action tags from within the broadcast advertisement (Col. 18, lines 8-23 and Col. 19, lines 15-40), the EPG being represented by a signal generated by a set top terminal (STT) using software programs stored in a memory of the STT (Col. 9, lines 42-55), wherein the software programs at the set top terminal interpret the data structure to provide the link and determine EPG controls that is presented and used in conjunction with the broadcast advertisement (browser and its associated API in the STB draws/redraws various pages of EPG along with its associated broadcast advertisement; see Col. 6, lines 35-40; Col. 9, lines 33-Col. 10, lines 65; Col. 13, lines 58-65, Col. 18, lines 8-23; Col. 19, lines 15-40), wherein the data structure is formatted in combination with the broadcast advertisement for broadcast to the set top terminal (Col. 5, lines 35-Col. 6, lines 67; Fries further discloses that the page image, i.e., commercial, could be formatted with video and audio for broadcast based on the configuration of the Advertiser/Broadcaster of the system because the IPF file includes an image tag (video), a program information tag and meta-data tag (audio) in which both the "Ur1" of the image tag and the meta-data tag could be

assigned to the corresponding video file and audio file, as shown in Col. 20, lines 32-67+).

Claim 3, limitation "wherein each of the one or more electronic program guide action tags are marked by an opening and a closing tag, the opening and closing tag operative to define a data type for each of the one or more electronic programming action tags" is inherently met by the well known HTML tags using as a delimiter for each action tag or event, as described by Fries in; see Col. 8-15;

Claim 4, "wherein the opening and closing tag enclose the valid electronic program guide feature in order to delimit the valid electronic program guide feature from another valid electronic program guide feature." is further met by Fries because it is an inherently well-known feature of the standard HTML Tag using as a delimiter for each EPG feature (i.e., buy ppv), as described by Fries; see Col. 8-15;

Claim 5, Fries further discloses wherein the valid electronic program guide feature (i.e., buy ppv) comprises an electronic program guide action parameter (i.e., set time to record/remind when the ppv movie is available) of a data type (ppv movie) corresponding to the opening and closing tag (Col. 18, lines 7-65).

Claim 9, Fries further discloses wherein the EPG action parameter comprises ppv purchase information (Col.18, 18-22).

Claim 10, Fries further discloses wherein the EPG action parameter comprises information to set a future reminder for a program (Col. 18, lines 15-18 and lines 45 of table, same col. 18);

Claims 11 and 12, Fries further discloses wherein the EPG action parameter comprises a network address, wherein the network address is an Internet address (Col. 18, lines 24-30).

Claim 13-16, limitations “wherein the one or more data tags comprises ppv information, wherein the ppv information comprises program date information, wherein the ppv information comprises program time information, wherein the ppv information comprises program channel information” is inherently met by Fries because ppv information inherently has these claimed limitation in order for the user to recognize the title of the ppv movie, the date and time of the ppv movie is available for buying and of course the channel associate with the ppv movie for the user to tune to (col. 18, lines 10-20).

Claim 17, Fries further discloses wherein the one or more data tags comprise a unique advertisement identifier (see Fig. 6 with unique page elements thereon; Col. 6, lines 65-Col. 9, lines 35);



Claim 18, Fries further discloses wherein the identifier comprises a key to locate additional program information from a set of guide data (see Fig. 6 with unique page elements thereon, in which the user could select one of the element to obtain additional information regarding the selected element; Col. 6, lines 65-Col. 9, lines 35);

Claim 19, Fries further discloses wherein the one or more data tags comprise a unique product identifier (see Fig. 6, i.e. Market report);

Claim 20, Fries further discloses wherein the identifier comprises a key to locate additional program information from a set of guide data (see Fig. 6 with unique page elements thereon, in which the user could select one of the element to obtain additional information regarding the selected element; Col. 6, lines 65-Col. 9, lines 35);

Claim 21, the method claim is analyzed with respect to claim 1.

2. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fries (US 6317885) in view of Lawler et al. (US 5805763).

Claim 6, 7, and 8, Fries indicates that a PPV program (broadcast advertisement) could be set to be recorded, but fail to indicate the location to record

Art Unit: 2623

such as a local location or a remote location to record/store the PPV program (broadcast advertisement).

Lawler discloses in response to a user selection for recording, the system set a record tag which indicates the location for recording the program selected, i.e., locally or remote location (Col. 2, lines 15-30 and Col. 13, lines 14-32). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Fries with Lawler so to give to user options to store information at different location as desired.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is (571) 272-7305. The examiner can normally be reached on M-F.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HT:ht  
08/17/2006

  
HAITRAN  
PRIMARY EXAMINER